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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,446	09/05/2003	Steven K. Coulthard	16217-002001	8480
26181	7590	10/30/2006		EXAMINER
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				MAYES, DIONNE WALLS
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,446	COULTHARD, STEVEN K.	
	Examiner	Art Unit	
	Dionne Walls Mayes	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11, 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-6, 8-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks (U.S. Patent No. 6,463,936).

Regarding claims 1 and 11, In the Figure 5 embodiment, Hicks teaches an apparatus for extinguishing and containing a cigarette, the apparatus comprising a container having an open end (said end obviously able to be structured as "permanently opened", since one having ordinary skill in the art would have been motivated to adapt an "open end" embodiment that is free from a closure mechanism - i.e. cap or lid - similar to that disclosed in Figs. 3A- 4, to enable unblocked and immediate cigarette access); a hollow interior having a substantially constant interior diameter; a closed end,

wherein the open end is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette; a clip including: a first portion grasping an exterior of the container; and a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm (Figure 5). Hicks fails to explicitly teach that the distal end of the first and the distal end of the second are not connected to each other; however, this minor distinction is not deemed to patentably distinguish the claims from the reference since one having ordinary skill in the art would have been motivated to use any conventional clippings means, including those which arms are detached, in order to secure the cigarette lighter. Also, while Hicks may fail to explicitly teach a bottle opener integral to the exterior of the container, this does not mean that an exterior portion of the container of Hicks could not be used for the purpose of opening bottles. For instance, the projection 48, could serve the function of "bottle opener" for some types of bottles, i.e. bottles having foil-type lids. Therefore, it is believed that this "bottle opener integral with the exterior of the container" limitation has been met. Accordingly, claim 1 is rejected.

Regarding claims 2 and 12, Hicks teaches the container is a cylindrical container (Figure 5). Accordingly, claim 2 is rejected.

Regarding claims 3 and 13, the projection 48 of Hicks can be used as a can tab. Accordingly, claim 3 is rejected.

Regarding claims 4 and 14, Hicks teaches that the interior diameter of the container is such that a lit cigarette will lodge in the interior of the cylindrical container and self-extinguish (column 2, lines 7-10). Accordingly, claim 4 is rejected.

Regarding claim 5, Hicks fails to teach that the interior of the closed end of the container is a convex surface extending toward the open end. However, due to a lack of criticality and unexpected results, designing the container such that the interior of the closed end of the container is a convex surface extending toward the open end is a matter of design choice. Accordingly, claim 5 is rejected.

Regarding claims 6 and 15, Hicks teaches the container comprises a heat-resistant plastic (column 3, lines 30-31). Accordingly, claims 6 and 15 are rejected.

Regarding claim 8, Hicks fails to teach the container is connected to the clip by a snug-fit connection. However, due to a lack of criticality and unexpected results, it would have been obvious to one of ordinary skill in the art to connect the clip to the container by a number of different ways, include using a snug-fit connection. Accordingly, claim 8 is rejected.

Regarding claim 9, Hicks teaches the first portion of the clip includes two or more grooves (point where area bowed region 66 meets area indicated by 64 on each side of container) on an exterior of the first portion (indicated by reference portion 64 in Figure 5) adapted to receive the fingers of a user of the apparatus. Accordingly, claim 9 is rejected.

Regarding claims 10 and 17, it would have been obvious to one having ordinary skill in the art at the time of the invention to have connected a releasable clip to the

container for easy removal on and off the container. Accordingly, claims 10 and 17 are rejected.

4. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks as applied to claim 1 above, and further in view of Hawley's Condensed Chemical Dictionary (pgs. 3 and 1097).

Hicks teaches that the container is made from a heat-resistant plastic (column 3, lines 30-31). Hicks fails to teach that the clip is made from a heat-resistant plastic. Hicks also fails to teach that the container and the clip comprise a glass filled ABS plastic. Hawley's Condensed Chemical Dictionary teaches that ABS resins or plastics are any of a group of tough, rigid thermoplastics (pg. 3). Thermoplastics are high polymers that soften when exposed to heat and return to their original condition when cooled to room temperature (pg. 1097). They are heat-resistant. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hicks with the teaching of Hawley's Condensed Chemical Dictionary making the container and the clip of the apparatus from an ABS plastic, specifically a glass filled ABS plastic, because such plastics are heat resistant and could withstand being exposed lit cigarettes. Accordingly, claims 7 and 16 are rejected.

Response to Arguments

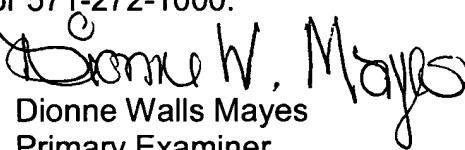
5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Dionne Walls Mayes
Primary Examiner
Art Unit 1731

October 28, 2006